

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

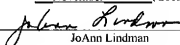
Application No.:	10/044,368	Confirmation No.:	8240
Applicant :	Thomas E. Broome et al.		
Filed :	January 10, 2002		
TC/A.U. :	3773		
Examiner :	Erezo, Darwin P.		
Title :	DISTAL PROTECTION FILTER		
Docket No. :	1001.1388101		
Customer No. :	28075		

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

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By

  
JoAnn Lindman

Dear Sir:

In response to the Final Office Action of August 25, 2009 and the Advisory Action of October 29, 2009, Appellants hereby request a Pre-Appeal Conference and file this Pre-Appeal Conference Brief concurrently with a Notice of Appeal. Appellants submit that the Examiner's rejections contain at least the following clear errors and/or omissions of one or more essential elements needed for a *prima facie* rejection.

Claims 52, 54, 55, 57-63, 70-72, 74, 75, 77-83, and 90-95 were rejected under 35 U.S.C. §102(e) as anticipated by Wholey et al. (U.S. Patent No. 6,652,554). After careful review, Appellants must respectfully traverse the rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.

1987)...“The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (MPEP 2131).

Independent claims 52 and 72 contain similar limitations:

Both claims recite, in part, the filter membrane or region further comprising a first generally linearly tapered portion and a second generally linearly tapered portion,

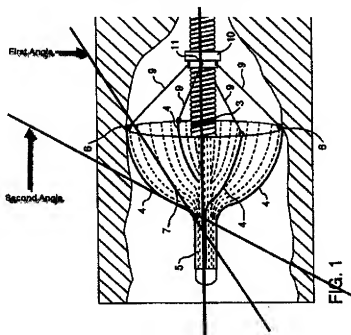
Claim 52 includes the limitation: the first tapered portion defining a first included angle, and the second tapered portion extending proximally from a proximal portion of the first tapered portion, the second tapered portion defining a second included angle greater than the first included angle. Claim 72 includes the limitation: the first tapered portion defining a first included angle and the second tapered portion defining a second included angle which is different than the first included angle.

Both claims also include the limitation: wherein the first tapered portion extends at the first included angle for a substantial length of the first tapered portion and the second tapered portion extends at the second included angle for a substantial length of the second tapered portion.

In the Final Office Action, the Examiner asserts that Wholey et al. disclose “first and second tapered portions include portions that “generally linearly”” [sic], stating that the “amended limitation merely requires the structure having two points that are “generally linearly”” [sic]. The Examiner goes on to arbitrarily designate two lines as corresponding to the portions that are generally linear, shown in FIG. 1 below. Appellants believe that the disclosure of Wholey et al. has been mischaracterized.

The pending claims require a membrane having two distinct tapered portions that define two different included angles. Wholey et al. appear to disclose a single cup-shaped filter segment formed with a curved surface, as evidenced by Figures 1 and 2. Regardless of if it is even possible for the filter of Wholey et al. to be considered tapered, one skilled in the art will recognize that Wholey et al. disclose a curved filter surface. In making the rejection, the Examiner has added lines to FIG. 1 of Wholey et al. that appear to define two different angles relative to a central longitudinal axis of the filter. However, one skilled in the art will certainly recognize that a straight line can only touch a curved surface at a single point, the point of tangency. Since the constantly curving

surface of the filter can only touch the line at a single point, the curved surface of the filter cannot be considered to be linear anywhere along its extent.



Similarly, Appellants readily recognize that only two points are required to define a line. However, a line connecting two arbitrary points on a 3-D curved surface or membrane will intersect that surface or membrane, rather than lie along it. However, a line intersecting a 3-D curved surface or membrane cannot be considered to be a generally linear portion of that surface or membrane. The Examiner appears to be confusing the arbitrarily selected lines shown above with the claimed generally linear portion of the membrane. Respectfully, Appellants point out that a line connecting two points on a curved surface does not define a linear portion of that surface.

In the Advisory Action, the Examiner states: “as stated in the Final Office action mailed on 8/25/09, the limitation does not clearly state the length of each “generally linearly tapered portion”...a generally linear portion merely requires two points that can form a line”. With all due respect to the Examiner, nowhere in the Final Office Action is the limitation the first tapered portion extends at the first included angle for a substantial length of the first tapered portion and the second tapered portion extends at the second included angle for a substantial length of the second tapered portion (emphasis added) discussed other than to broadly assert that Wholey et al. disclose such a limitation. Appellants must respectfully disagree. As discussed above, the filter of Wholey et al.

appears to be curved in its entire extent. Therefore, at any point along its surface, there cannot be a linear portion disposed on the surface at any given angle relative to the central longitudinal axis.

If given an unreasonably broad interpretation, one not accepted by Appellants but introduced for the sake of discussion, and the lines drawn by the Examiner on FIG. 1 of Wholey et al. were considered to touch the surface of the filter at two distinct intersecting points – once along the convex outer surface of the filter and again where the filter turns parallel to the central axis at a point distal to the convex surface – the surface of the filter still does not extend linearly between these two points, but instead forms an s-shaped curve. In order to meet the Examiner's definition of linear, the curved surface of Wholey et al. must be made infinitely large so as to make the curve imperceptible, or the asserted linear portion must be infinitesimally small to bring the two points on the line close enough together to be considered linear. Appellants submit that neither definition is proper based upon the disclosure of Wholey et al. Modification of Wholey et al. to produce an infinitesimally large curve would impermissibly alter the principle of operation of Wholey et al., rendering it unsuitable for its intended use (MPEP 2143.01 V-VI). Bringing two points close enough together on a curved surface to be considered linear on that surface would not meet the limitations of the claims that require the tapered portion to extend at the included angle for a substantial length of the tapered portion. Accordingly, Appellants submit that one skilled in the art would not properly or reasonably reach the conclusion set forth by the Examiner in the rejection.

For at least the reasons discussed above, Wholey et al. do not appear to disclose each and every element set forth in the claims in as complete detail as is found in independent claims 52 and 72. Therefore, Wholey et al. cannot anticipate the claims. Since claims 54, 55, 57-63, 70-71, 74, 75, 77-83, and 90-95 depend from claims 52 and 72 and add additional limitations thereto, Appellants believe these claims are also not anticipated by Wholey et al. Therefore, Appellants respectfully request that the rejection be withdrawn.

Claims 56 and 76 were rejected under 35 U.S.C. §103(a) as being unpatentable over Wholey et al., as applied to claims 52 and 72, in view of Daniel et al. (U.S. Patent No. 5,814,064). Claims 64-69 and 84-89 were rejected under 35 U.S.C. §103(a) as being

unpatentable over Wholey et al., as applied to claims 52 and 72, in view of Mazzocchi et al. (U.S. Patent No. 6,605,1024). After careful review, Appellants must respectfully traverse the rejections.

"All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). (MPEP 2143.03).

For at least the reasons set forth above, Wholey et al. do not appear to teach each and every element of independent claims 52 and 72. Neither Daniel et al. nor Mazzocchi et al. appear to remedy the shortcomings of Wholey et al. with respect to claims 52 and 72. Therefore, claims 52 and 72 are believed to be patentable over the proposed combinations. Since claims 56, 64-69, 76, and 84-89 depend therefrom and add additional elements thereto, these claims are also believed to be patentable over the cited combinations. Appellants respectfully request that the rejections be withdrawn.

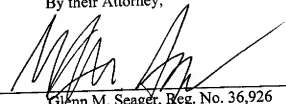
In view of the foregoing, all pending claims are believed to be in condition for allowance. Withdrawal of the rejections is respectfully requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Thomas E. Broome et al.

By their Attorney,

Date: Nov. 18, 2009

  
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